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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/407,126  
Filing Date: September 27, 1999  
Appellant(s): BOSSEMEYER ET AL.

**MAILED**

SEP 06 2007

**GROUP 3600**

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Vincent J. Gnoffo  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 05/24/2007 appealing from the Office action  
mailed 01/25/2007

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,324,273	Alcott	November 2001
US 4,897,866	Majmudar et al.	January 1990

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 5-12,14-19 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcott (US 6,324,273) in view of Majmudar et al. (US 4,897,866) (Majmudar).**

#### **Independent Claims**

As per claims 1, 10 and 17, Alcott teaches a computer-implemented method and system for ordering a telecommunication service, wherein the use of the computer indicates the use of the computer-readable medium having a computer-readable instructions imbedded therein, which, when executed by the computer, causing said computer to implement said method, comprising:

inquiring in a first transaction about a first telecommunication feature unavailable to a first party of a telecommunication network (determining, in accordance with an inquiry of the originating first party, an availability of a telecommunication feature for the party of a telecommunication network) (C. 3, L. 62 - C. 4, L. 4, 38-39);

in accordance with the inquiring in the first transaction, storing a first data structure which identifies the first party of a telecommunication network and the first telecommunication feature unavailable to the first party (said step is performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53; C. 3, L. 62 - C. 4, L. 4, 38-39);

inputting (providing) availability data which indicates an availability of the first telecommunication feature to a portion of the telecommunication network which serves the first party (C. 3, L. 62 - C. 4, L. 4);

providing availability data of the first telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 62 - C. 4, L. 4);

determining that the first telecommunication feature has become available to the first party based on the first data structure and the availability data (C. 4, L. 15-25);

informing the first party that the first telecommunication feature is available (creating an account and providing a billing record to the originating party) (C. 4, L. 25-30). Furthermore, Alcott teaches that said informing is implemented or via written communication (C. 4, L. 31-36), or via initiating an automatic call back (C. 5, L. 53-60).

Alcott does not explicitly teach that said "inputting" step and "informing/placing a call" step are occurring after completion of the first transaction and after upgrading the portion of the telecommunication network which serves the party.

Majmudar teaches a computer-implemented method and system for providing a telecommunication service to a subscriber, wherein, after the subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature. After this event (indicates after completion of the first transaction), if user lifts a handset to originate a call, the terminal will display the requested new feature (indicates informing the first party that the first telecommunication feature has become available, wherein said "informing" occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data), and wherein said "informing" occurs before the first party has subscribed (utilized said feature and billed for, C. 5, L. 67) to the first telecommunication feature." (Abstract; C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring *after completion of the first transaction; upgrading* the network which serves the first party to

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provide the requested by the first party the telecommunication feature; and *informing the first party that the first telecommunication feature has become available*, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have; and to improve customer service by allowing subscribers to inquire for the desired feature only once.

As per claim 9, Alcott teaches:

receiving a first call from a first party of a telecommunication network (C. 3, L. 62 - C. 4, L. 4);

determining that a first telecommunication feature is unavailable to the first party (C. 3, L. 62 - C. 4, L. 4, 38-39);

storing a first data structure which identifies the first party and the first telecommunication feature unavailable to the first party (the step of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" is performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53; C. 3, L. 62 - C. 4, L. 4, 38-39);

inputting (providing) availability data which indicates an availability of the first telecommunication feature to a portion of the telecommunication network which serves the first party (C. 3, L. 62 - C. 4, L. 4);

processing the inputted and stored data to determine that the telecommunication feature has become available to the first party based on the first data structure and the availability data (C. 4, L. 15-25).

Alcott does not explicitly teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the first party, *is occurring after completion of the first transaction and after upgrading the portion of the telecommunication network* which serves the party. Also, while Alcott teaches informing the first party that the first telecommunication feature is available (creating an account and providing a billing record to the originating party)(C. 4, L. 25-30), wherein said "informing" occurs in response to the inquiring in the first transaction, Alcott does not specifically teach that

said "informing" step includes informing the first party that the first telecommunication feature *has become available*, wherein said "informing" *occurs in response to the upgrading the portion of the communication network* and the processing of the first data structure and the availability data.

Majmudar teaches said method and system for providing a telecommunication service to a subscriber, wherein, after the subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature. After this event (indicates after completion of the first transaction), if user lifts a handset to originate a call, the terminal will display the requested new feature (indicates informing the first party that the first telecommunication feature has become available, wherein said "informing" occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data), and wherein said "informing" occurs before the first party has subscribed (utilized said feature and billed for, C. 5, L. 67) to the first telecommunication feature." (Abstract; C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction; upgrading the network which serves the first party to provide the requested by the first party the telecommunication feature; and informing the first party that the first telecommunication feature has become available, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have; and to improve customer service by allowing subscribers to inquire for the desired feature only once.

Also, Alcott and Majmudar does not specifically teach that said originating (first) party includes a second and a third party, and that said inquired (first) feature includes a second and a third feature. However, the method steps disclosed in Alcott and Majmudar indicate continuity of the disclosed method, because it would not be feasible to implement said system for one (first) customer only, and only for one (first) feature.

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Furthermore, the method steps, disclosed in Alcott and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Majmudar to include that said originating party includes a second and a third party, and that said inquired feature includes a second and a third feature, because it would advantageously allow to accommodate various needs of different subscribers. As per "determining that the first telecommunication feature has become available to the first party *but remains unavailable to the third party*", it is noted that Alcott teaches that the telecommunication feature can be available or unavailable to the originating party based on whether *the credit check is satisfied or unsatisfied* (C. 4, L. 15-17, 37-39), thereby suggesting *that the first telecommunication feature remains unavailable to the third party* because of the *unsatisfied credit check* of the third party.

#### Dependent Claims

Furthermore, Alcott teaches:

As per claims 2, 11 and 18,

identifying another party of the telecommunication network and another a telecommunication feature unavailable to another party; determining an availability of the telecommunication feature for another party of a telecommunication network; and determining that the telecommunication feature unavailable to another party (C. 3, L. 48-53; C. 3, L. 62 - C. 4, L. 4). As per "storing" feature, the method steps recited are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53).

As per claims 3, 12 and 19, identifying another party of the telecommunication network and another telecommunication feature unavailable to another party; and determining that another telecommunication feature unavailable to another party (C. 3, L. 48-53; C. 3, L. 62 - C. 4, L. 4). As per "storing" feature, the method steps recited are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53).



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As to second party and second telecommunication feature, the method steps disclosed in Alcott and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Majmudar to include that said originating party includes a second party, and that said inquired feature includes a second feature, because it would advantageously allow to accommodate various needs of different subscribers.

As per claim 5, said method and system, comprising: prior to inputting the availability data,

receiving a call from the party, and informing in the call that the first telecommunication feature is unavailable to the party (C. 1, L. 11-33; C. 3, L. 41 - C. 4, L. 4).

As per claims 6, 14 and 21, said method and system, wherein the first telecommunication feature comprises a telecommunication service (C. 1, L. 6-7).

As per claims 7, 15 and 22, said method and system, wherein the first telecommunication feature comprises a telecommunication product (C. 1, L. 6-7).

As per claims 8, 16 and 23, said method and system, wherein the telecommunication network comprises a telephone network (C. 1, L. 62 - C. 2, L. 12).

As per claims 24-30, Same reasoning as applied to the independent claims.

## **(10) Response to Argument**

(10. 01) Argument A. Claim 1.  
(Brief, pages 6-7)

(10.011) Applicant argues that the prior art fails to disclose:

*"placing a call to the first party to inform the first party that the first telecommunication feature has become available, wherein placing the call to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature."*

In response to this argument it is noted that claim 1 required that said *"placing the call to inform the first party that the first telecommunication feature has become available"* step is conducted after *upgrading the portion of the telecommunication network*. Accordingly, Majmudar was applied to show selecting, by a subscriber, a feature which is not available first for the subscriber; upgrading/assembling the software modules to enable the selected feature; and displaying the requested new feature (informing the subscriber that the selected feature has become available), wherein said "informing" occurs before the first party has subscribed (utilized said feature and billed for, C. 5, L. 67) to the first telecommunication feature." (Abstract; C. 6, L. 1-17).

As per *"placing the call to inform the first party regarding availability of the first telecommunication feature"*, Alcott teaches informing the first party *that the first telecommunication feature is available* (C. 4, L. 15-25), wherein said informing is conducted or via written communication (C. 4, L. 31-36), or via initiating an *automatic call back (placing a call)* (C. 5, L. 53-60).

(10.012) Applicant argues that the selected feature in Mujmudar is clearly 'available' to the party.

In response to this argument it is noted that Mujmudar explicitly teaches that the terminal has to be upgraded before the subscriber is able to utilize the selected feature (C. 6, L. 8-17). If the new terminal package reflecting the updated feature is not loaded into the terminal, the subscriber is not able to utilize the selected feature, and, as such, said new feature is unavailable to the subscriber.

(10.013) Applicant argues that neither reference, alone or in combination, discloses: "*informing a first party of a new feature by placing a call 'to' the first party*"; and: "placing the call to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature."

In response to these arguments it is noted that said arguments are essentially the same as arguments presented above. Accordingly, the responses presented by the examiner above are equally applicable here.

(10.014) Applicant argues that there is no motivation to combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Alcott and Majmudar relate to offering telecommunication services to subscribers, wherein said features could be available or not to a particular subscriber. The motivation to modify Alcott to include *informing the subscriber that the first telecommunication feature has become available after upgrading the network* which serves the subscriber party to provide the requested by the subscriber telecommunication feature would be to advantageously allow accommodate various needs subscribers may have; and to improve customer service by allowing subscribers to inquire for the desired feature only once.

Furthermore, Claim 1 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR* because the improvements are no more than the predictable use of prior art elements according to their established functions, *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

(10. 02)

Argument B. Claim 9.  
(Brief, page 8)

Applicant argues that the prior art does not disclose or suggest that second and third calls are also made by second and third parties; that the first party is notified in a fourth call after upgrading the portion of the telecommunication network that the first telecommunication feature has become available to the first party by placing a call to the first party; and that the first party has the opportunity to subscribe to the first telecommunication feature after the fourth call is placed."

In response to this argument it is noted that the method steps disclosed in Alcott and Majmudar indicate continuity of the disclosed method, because it would not be feasible to implement said system for one (first) customer only, and only for one (first) feature. Furthermore, the method steps, disclosed in Alcott and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Majmudar to include that said originating party includes a second and a third party, and that said inquired feature includes a second and a third feature, because it would advantageously allow to accommodate various needs of different subscribers. As per "upgrading the portion of the telecommunication network" and the "opportunity to subscribe to the first telecommunication feature after said "upgrading"

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step", it is noted that said arguments are essentially the same as arguments presented above. Accordingly, the responses presented by the examiner above are equally applicable here.

(10. 03)

Argument C. Claim 10.  
(Brief, pages 8-9)

Applicant's arguments in response to claim 10 are essentially the same as arguments presented above in respect to claim 1. Accordingly, the responses presented by the examiner above are equally applicable here.

(10. 04)

Argument D. Claim 17.  
(Brief, page 9)

Applicant's arguments in response to claim 17 are essentially the same as arguments presented above in respect to claim 1. Accordingly, the responses presented by the examiner above are equally applicable here.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

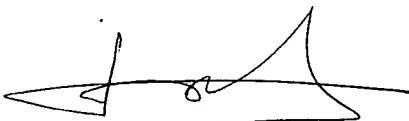
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor Borissov



IGOR N. BORISSOV  
PRIMARY EXAMINER

Conferees:

Vincent Mullin



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